<u>REMARKS</u>

Reconsideration of this application as amended is respectfully requested.

In the Office Action, claims 1-13, 15-19, 22, and 24-70 were pending and rejected. In

this response, claims 5, 8-9, 14, 20-21, 23, 41, 46-49, and 64-70 have been canceled without

prejudice. Claims 1-4, 6, 7, 10-13, 15-19, 22, 24-29, 31-33, 35-39, 42-45, 50, 52-56, 59, and

62-63 have been amended. No new matter has been added.

Claims 1-13, 15-19, 22, and 24-70 are rejected under 35 U.S.C. 103(a) as being

unpatentable over EPA 0 581 722 of Ehud Shapiro ("Shapiro") in view of U.S. Patent No.

5,790,793 of Higley ("Higley"). In view of the foregoing amendments, it is respectively

submitted that the current pending claims include limitations that are not disclosed by the

cited references, individually or in combination. Specifically, independent claim 1 as

amended recites as follows:

> 1. (Currently Amended) A method for real-time network communication,
> comprising:
> forming real-time communications protocol connections between chat clients
> and a chat server over network communications connections;
> one of the chat clients <u>embedding a markup language instruction in a chat-
> session message</u>;
> the one chat client sending the chat-session message on one of the real-time
> communications protocol connections to the chat server;
> in response to receiving the sent chat-session message, the chat server sending
> the chat-session message on one of the real-time communications protocol connections
> to another of the chat clients; and
> in response to receiving the sent chat-session message, <u>the other chat client
> marking up the received chat-session message according to the embedded instruction
> and displaying the marked-up chat-session message</u>.

(Emphasis added)

Independent claim 1 includes forming a real-time chatting communications protocol

connection (e.g., using IRC protocol) between a chat client and a chat server and embedding a

markup language instruction within the chat-session message. When another chat client receives the chat-session message having the markup language instruction embedded therein, the receiving chat client marks up the chat-session message according to the embedded instructions and displays the marked-up chat-session message. It is respectfully submitted that the above limitations are absent from the cited references, individually or in combination.

Rather, Shapiro relates to establishing a socket connection between two workstations using an email. When a first workstation initiates the socket connection, it encodes socket information within an email and sends the email to a second workstation which is stored in an inbox of the second workstation. When the second workstation opens the email and obtains the socket information of the first workstation, the second workstation establishes a socket connection with the first workstation using the socket information of the first workstation (see, Abstract, Fig. 5, and page 5 of Shapiro).

It is respectfully submitted that such a socket connection is not a real-time chatting communications protocol connection, using for example, IRC protocol, between a chat client and a chat server. There is no mention or suggestion within Shapiro of using real-time chatting communications protocols.

Similarly, Higley relates to sending a URL within an email such that a recipient can retrieve a Web page based on the URL without having to display the email message itself. Such email message exchanges are not the real-time chatting communications either (e.g., a continuously-open bi-directional protocol connection), particularly, between a chat client and a chat server.

In addition, there is no suggestion within Shapiro and Higley to combine with each other. Shapiro is concerned about initiating a socket connection without disrupting the other partner by sending the invitation through an email which the other partner may ignore by

letting it sit in the inbox (See, for example, page 2, line 51 to page 3, line 14), while Higley relates to transmitting a URL via an email without having to transmitting the content of the document linked by the URL. Shapiro and Higley are solving significantly different problems and their approaches are significantly different. It is respectfully submitted that one with ordinary skill in the art, based on the teachings of Shapiro and Higley, would not combine these two references because such a combination lacks a reasonable expectation of success. Such a suggestion can only be found in Applicant's disclosure. It would be impermissible hindsight to use Applicant's own disclosure against the Applicant.

Even if, for the sake of the argument, Shapiro and Higley were combined, such a combination still lacks the limitations set forth above. Therefore, for the reasons discussed above, it is respectfully submitted that independent claim 1 is patentable over the cited references.

Similarly, independent claims 10, 22, 29, 33, 39, 50, and 56 include limitations similar to those recited in claim 1. Thus, for the reasons similar to those discussed above, independent claims 10, 22, 29, 33, 39, 50, and 56 are patentable over the cited references.

Given that the rest of the claims depend from one of the above independent claims, at least for the reasons similar to those discussed above, it is respectfully submitted that the rest of the claims are patentable over the cited references. Withdrawal of the rejections is respectfully requested.

In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 6/29/2004

Kevin G. Shao
Attorney for Applicant
Reg. No. 45,095

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(408) 720-8300